APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,541	03/31/2004	William D. Goldberg	RSW920040016US1	7408

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EXAMINER
ANDERSON, FOLASHADE

ART UNIT	PAPER NUMBER
3623	

NOTIFICATION DATE	DELIVERY MODE
06/24/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mld@mindspring.com

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03/31/2010*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *18-21,28,33,35,36 and 38* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *18-21,28,33,35,36 and 38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Status of Claims

1. This Non-final office action is in response to Applicant's amendment filed 3/31/10. Currently, claims 18-21, 28, 33, 35, 36 and 38 are pending. Claims 18, 19, 28, 33, 35, 36, and 38 have been amended. Claims 1-17, 22-27, 29-32, 34 and 37 have been canceled.

Response to Amendment

2. Applicant's amendments to the drawings and specification are acknowledged.

3. Applicant's amendments to claims 18 and 28 removing "suitable" from the claimed limitation are sufficient to overcome the 35 U.S.C 112, second paragraph rejection set forth in the previous action.

4. Applicant's cancellation of claims 32, 34 and 37 along with the amendments to claims 35, 36 and 38 removing reference to " gap value for each of the business objectives" are sufficient to overcome the 35 U.S.C. 112, first paragraph rejections set forth in the previous action.

Response to Arguments

5. It is note that Applicant's cancellation and amendments to claims 32-35 and 37-38 resolve any issues with the claims that gave rise to the 35 U.S.C 112, first paragraph of the previous action and new 35 U.S.C.112, first paragraph rejections are made this action.

6.   It is noted that Applicant's arguments filed with respect to the previously made 35

U.S.C. 102 and 35 U.S.C. 103 rejections are directed towards *newly amended claim*

language which is fully addressed the updated rejection.

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

8.   Claim 18, 20, 21, 28, 33, 35, 36 and 38 rejected under 35 U.S.C. 103(a) as being

unpatentable over Keay et al (US Publication 2005/0065831 A1) in view of

Srinivasan et al (US Patent 6,895,382)

Claim 18 is the method used in conjunction with the system of claim 28, it is

substantially similar and is therefore rejected based on the same reasoning given below

with respect to claim 28.

Claim 20 Srinivasan teaches the method according to Claim 18, wherein the

assigned resources are information technology personnel (Srinivasan col. 26, lines 1-5).

Claim 21 Srinivasan teaches the method according to Claim 18, wherein the assigned resources comprise monetary investments in the particular location (Srinivasan skills rate table col. 26, lines 30-67).

Claim 28 Keay teaches a system for assigning resources, comprising:

- a computer comprising a processor (Keay 0002, 0041);

- a set of business objectives for assessing each of a plurality of one or more candidate locations for resource placement (Keay 0016);

- one or more objective measurements for each business objective (Keay 0093, 0100);

- results of value chain analyses performed related to the set of business objectives, the results usable for determining what resources will potentially improve the analyzed value chain (Keay figures 4A & 4B and 0095-0100);

- cost factors for costs of placing the determined resources in the candidate locations (Keay 0043, 0058);

- instructions which are executable on the computer, using the processor, to implement functions comprising (Keay 0105):

    o programmatically computing a value for placing the resources in each of the candidate locations using the business objectives, according to the developed objective measurements, and the developed cost factors (Keay 0093, 0100), further comprising:

    o using the programmatically-computed value to (Keay 0043, 0058);.

Keay further teaches business simulations (Keay 0043) selection of business process to be performed (Keay 0058); however Keay does not teach the limitation of programmatically select a particular location from among the candidate locations, based on the programmatically-computed value for placing the resources in each of the candidate locations, thereby enabling assignment of the determined resources for placement in the programmatically-selected particular location. Additionally Keay does not teach:

- o determining an importance value for a first plurality of the business objectives;

- o determining, for a second plurality of the business objectives, a location-specific score for each of the candidate locations that reflects how well the candidate location meets the second plurality of business objectives;

- o using the location-specific scores and corresponding ones of the importance values to compute a plurality of gap values for each of the candidate locations; and

- o for each of the candidate locations, using the computed gap values and the developed cost factors to yield the value for placing the resources in the candidate location; and

Srinivasan does teach programmatically select a particular location from among the candidate locations, based on the programmatically-computed values, thereby enabling assignment of the determined resources for placement in the programmatically-selected particular location (Srinivasan col.6, lines 17-49) and

       o determining an importance value for a first plurality of the business objectives (Srinivasan, see table 2 and accompanying text);

       o determining, for a second plurality of the business objectives, a location-specific score for each of the candidate locations that reflects how well the candidate location meets the second plurality of business objectives (Srinivasan, see chart at col. 26 lines 40-67);

       o using the location-specific scores and corresponding ones of the importance values to compute a plurality of gap values for each of the candidate locations (Srinivasan col. 11, lines 27-29);

       o for each of the candidate locations, using the computed gap values and the developed cost factors to yield the value for placing the resources in the candidate location (Srinivasan table 1.4 at col. 29 and 30);

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the invention of Keay the features as taught by Srinivasan since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 33 is the method used in conjunction with the system of claim 35, it is substantially similar and is therefore rejected based on the same reasoning given below with respect to claim 35.

Claim 35 The system according to Claim 28, wherein programmatically selecting a particular location further comprises selecting the candidate location for which a cost of placing the resource resources in the candidate location is lowest (Srinivasan table 1.4 at col. 29 and 30).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the invention of Keay the features as taught by Srinivasan since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 36 is the computer program product used in conjunction with the system of claim 28, it is substantially similar and is therefore rejected based on the same reasoning given above with respect to claim 28.

Claim 38 is the computer program product used in conjunction with the system of claim 35, it is substantially similar and is therefore rejected based on the same reasoning given above with respect to claim35.

9. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Keay et al

(US Publication 2005/0065831 A1) and Srinivasan et al (US Patent 6,895,382) in

further view of Baker et al (Project Management, 2nd Edition, published 2000).

Claim 19 Keay and Srinivasan teaches the method according to Claim 18; and

Srinivasan further teaches wherein programmatically computing the value for placing

each of the candidate locations (Srinivasan col. 2, lines 33-37 and col.6, lines 17- 33);

however Srinivasan is silent on, further comprises estimating and accounting for any lag

time characteristics discovered while performing the value chain analyses.

Baker teaches wherein the computing further comprises estimating and accounting

for any lag time characteristics discovered while performing the value chain analyses

(Baker p.113).

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to include the invention of Keay and Srinivasan the estimating and

accounting for any lag time characteristics discovered while performing the value chain

analyses as taught by Baker since the claimed invention is merely a combination of old

elements, and in the combination each element merely would have performed the same

function as it did separately, and one of ordinary skill in the art would have recognized

that the results of the combination were predictable.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FOLASHADE ANDERSON whose telephone number is (571)270-3331. The examiner can normally be reached on Monday through Thursday 8:00 am to 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Folashade Anderson/
Examiner, Art Unit 3623

/Andre Boyce/
Primary Examiner, Art Unit 3623